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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,262	10/04/2000	Geoffrey B. Rhoads	60304	7124

23735 7590 07/16/2003

DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 100  
TUALATIN, OR 97062

EXAMINER

THOMPSON JR, FOREST

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/679,262

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

Forest Thompson Jr.

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-11 have been examined.

***Priority***

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) to Provisional Application #60/158,015 is acknowledged.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kagami et al. (U.S. Patent No. 5,724,522), and further in view of Bloomberg (U.S. Patent No. 5,765,176).

Claims 1-11: Kagami et al. discloses:

- functionality that encompasses a method of providing a catalog that includes images or articles for sale by a merchant that include machine-readable indicia representing multi-bit data associated with said article; sensing the indicia to produce image data corresponding thereto; decoding the multi-bit image data; transmitting at least a portion of said multi-bit data to a first computer, together with data identifying the user; presenting selection data from the second

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computer to a user; receiving input from the user selecting among the presented selection data; transmitting said received input to the merchant; using user profile data to customize selection data presented to the user; transmitting selection data to a user computer; identifying clothes or accessories that may complement the selected image or article for sale; presenting at least certain of said clothes or accessories to a user on a display screen, using a synthesized model that also includes the selected image or article for sale. (fig. 3; fig. 4; fig. 5; fig. 6; fig. 7; col. 5 line 13 – col. 6 line 30; )

- using customer profile information to customize data presented to the user (col. 9 lines 25-27).
- transmitting selection data from the second computer to a user computer (col. 8 lines 21-37)

Kagami et al. does not specifically disclose scanning an image to detect steganographically encoded or digital watermark data. However, the use of digitally encoded information to perform a function (e.g., ordering a product or service) was old and well known in the art at the time the invention was made. Specifically, Bloomberg discloses:

*The field of innocuous, or surreptitious, image marking is known as steganography, or "covered writing." Data glyph technology is a category of embedded encoded information that is particularly advantageous for use in applications that require the embedded data to be robust for decoding purposes yet inconspicuous, or even surreptitious, in the resulting image. Data glyph*

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*technology encodes digital information in the form of binary 1's and 0's which are then rendered in the form of very small linear marks (col. 2 lines 43-51); and*

- *The machine readable attributes are recoverable from the code printed on the hardcopy document when information carried by the document is transformed from the hardcopy domain to the electronic domain, such as for example by scanning the physical document (col. 3 lines 28-32).*

Therefore, it would have been obvious to modify the disclosure of Bloomberg et al. to explicitly scan an image to detect steganographically encoded or digital watermark data, as disclosed by Bloomberg et al., for the motivation of providing an electronic commerce method.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art includes:

- Yoshida et al. (U.S. Patent No. 6,449,378) discloses reliably padding electronic water-mark information even in a moving image constituted by a plurality of frames whose contents hardly change and easily pad electronic water-mark information even in a general moving image obtained by photographing an object at one angle.
- Sakaguchi (U.S. Patent No. 6,310,627) discloses a 3D image of an object model and images of patterns of a garment are generated. The images of the respective patterns are three-dimensionally deformed by arranging them in corresponding portions of the 3D image of the object model in an image space,


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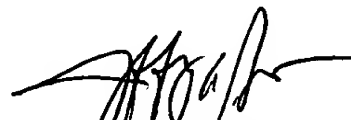
and calculating collision deformations caused when the respective patterns are pressed against the corresponding portions based on externally inputted information on the garment. A stereoscopic image of the garment is generated by connecting the deformed 3D images of the respective patterns based on the information on the garment. .

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
F. Thompson  
July 8, 2003

  
Jeffrey A. Smith  
Primary Examiner